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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,999	12/22/2005	Marc Riemenschnitter	RO0989US (#90568)	1652

7590 09/16/2009
D Peter Hochberg Co
The Baker Building-6th Floor
1940 East 6th Street
Cleveland, OH 44114-2294

EXAMINER

LEWIS, KIM M

ART UNIT	PAPER NUMBER
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3772

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09/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,999	Applicant(s) RIEMENSCHNITTER, MARC	
	Examiner Kim M. Lewis	Art Unit 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-44 is/are rejected.
- 7) ☒ Claim(s) 45 and 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/21/09 has been entered.
2. As requested in the submission, claims 32-38 have been amended, and claims 39-46 are newly added.
3. Claims 32-46 are pending in the instant application.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 32-38 are rejected under 35 U.S.C. 102(b) as being anticipated by WO93/06144 ("Gangadharan").

As regards claims 32-38, Gangadharan discloses adhesive products capable of use with medical patches or transdermal therapeutic systems (page 1, lines 5-15). The

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adhesive comprises a moisture activated adhesive composition and a hydrophobic adhesive polymer core (psa polymer component), wherein the psa component can be a polyacrylate (page 2, lines 21-29) and at least one component such as polyethers and acid anhydrides including acids salts of acid anhydrides such as methylvinyl ether/maleic acid copolymers (page 3, line 21- page 4, line 4) or a cellulose derivative such as carboxymethyl cellulose (page 3, lines 31-33). Applicant should also note that the disclosure of the adhesive being in the form of multilayer particulate on page 1, lines

As regards claim 39, note the disclosure of controlling moisture and a dried product on page 4, line 35- page 5, line 3.

As regards claims 41-43, note the rejection of claim 32 above, and page 5, lines 9-10, which discloses a polar solvent such as water.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gangadharan in view of U.S. Patent Application Publication No. 2004/0068036 ("Halliday").
9. As regards claim 44, Gangadharan discloses the adhesive composition of claim 44, but does not disclose the use of solvents, such as, hexane and ethyl acetate. Halliday, however, teaches that it known to coat compositions, wherein the coatings can be provided in a carrier liquid, such as the solvents hexane, ethyl acetate and water (paras. 0220, 0221 and 00224).

Thus, it would have been obvious to one having ordinary skill in the art to substitute the water solvent of Gangadharan for one of the disclosed solvents of Halliday, such as hexane or ethyl acetate, and to achieve a reasonable expectation of success, since Halliday discloses the equivalence of the solvents water, hexane and ethyl acetate, with the distinctive choice being the environment.
10. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gangadharan.

As regards claim 40, Gangadharan discloses controlling moisture and a dried product on page 4, line 35- page 5, line 3. Gangadharan fails to teach that the product is a dried film. However, the examiner contends that it would have been obvious to one having ordinary skill in the art to provide the adhesive in any form including a film

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depending upon the intended use. Applicant should note that varying the form/shape of the adhesive will allow the adhesive to be used differently (i.e., in differently body parts, on different elements, etc.).

Allowable Subject Matter

11. Claims 45 and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Monday to Wednesday, from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kim M. Lewis/
Primary Examiner
Art Unit 3772

Kml
September 12, 2009